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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,200	12/07/2001	Howard Allen Colvin	DN2000251	9470

7590

09/16/2002

The Goodyear Tire & Rubber Company
Patent & Trademark Department - D/823
1144 East Market Street
Akron, OH 44316-0001

EXAMINER

RAJGURU, UMAKANT K

ART UNIT	PAPER NUMBER
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1711

3

DATE MAILED: 09/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

JP

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-15 is/are pending in the application.
- ☐ Of the above claim(s) 2 and 8-14 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1, 3-7 and 15 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).
- *Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 2 Interview Summary, PTO-413
- ☒ Notice of References Cited, PTO-892 Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948 Other _____

Office Action Summary

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 3-7 and 15, drawn to a composition, classified in class 524, subclass 493.
- II. Claims 2 and 8-14, drawn to a process, classified in class 524, subclass 493.

The inventions are distinct, each from the other because:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make a materially different product such as a composition containing a thermosetting resin and a filler such as calcium carbonate, glass etc..

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

2. During a telephone conversation with Attorney Alvin T. Rockhill on 8/14/02 a provisional election was made with traverse to prosecute the invention of group I, claims 1, 3-7 and 15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2 and 8-14 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

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currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. Claims 1, 3-7 and 15 are under examination.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 3-7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over

WKL Mabry et al (USP 6075084) in view of Sandstorm et al (USP 6378582).

Mabrey describes elastomer composite blends and method. Suitable elastomer latex

fluids include both natural and synthetic elastomer lattices and latex blends. Styrene-butadiene rubber is one of the suitable lattices (col. 11, line 50 to col. 12, line 27). Certain fillers are also

WKL used. Fumed silica and precipitated silica are suitable fillers (col. 14, line 6-14). They possess an aspect ratio less than 40 (col. 15, lines 47-50).

1. 11. 1992
APR 30, 1992

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Though Mabrey discloses the aspect ratio, there is no mention about the size of silica particle.

Sandstorm describes silica-reinforced tire tread rubber. Tread is comprised of (1) 10 to 35 phr of vinyl butadiene rubber, (2) 65 to 90 phr of isoprene butadiene rubber, (3) 30 to 90 phr silica, (4) 5-50 phr black, (5) 2 to 50 phr of processing oil and (6) 0.5 to 15 phr of silica

MR ^{coupling}~~complying~~ agent (col. 17, lines 23-37). Average particle size of silica is 0.01 to 0.05 micron (i.e. 10 to 50 nanometers) (col. 8, lines 40-44).

Therefore it would have been obvious (from teachings of Sandstorm) that since suitable silica particle size lies between 10 to 50 nanometers the dimensions of the silica particles used by Mabry (based on aspect ratio of 40 maximum) are $(10 \times 40 =) 400$ nanometers to $(50 \times 40 =) 2000$ nanometers.

In this case the dimensions of particle of silica, disclosed by prior art are not exactly same as those that are instantly claimed. Nonetheless it is the examiner's position that one of ordinary skill in the art can always vary these dimensions in order to enhance dispersion of silica in polymeric matrix and also to better stabilize the dispersion so prepared.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to U. K. Rajguru whose telephone number is 703 308-3224. The examiner can normally be reached on Monday-Friday from 9:30 am to 6:00 pm.

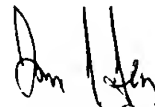
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 703 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9310 for regular communications and 703 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-0661.



Examiner Rajguru/ng
September 6, 2002



James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700